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**JUL 22 2009**

**OFFICE OF PETITIONS**

In re Patent No. 7,510,709	:
Austin L. Gurney	:
Issue Date: March 31, 2009	: DECISION ON REQUEST FOR
Application No. 10/697,599	: RECONSIDERATION OF
Filed: October 29, 2003	: PATENT TERM ADJUSTMENT
Attorney Docket No. GNE-0125	:

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b) filed Monday, June 1, 2009, which is properly treated under 37 CFR 1.705(d). Patentees request that the patent term adjustment determination for the above-identified patent be corrected from five hundred forty (540) days to seven hundred thirty-five (735) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 540 days.

On March 31, 2009, the above-identified application matured into U.S. Patent No. 7,510,709 with a revised patent term adjustment of 540 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees aver that the correct number of days of patent term adjustment is 735 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees contend that pursuant to Wyeth, periods of delay under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B)

overlap only if they occur on the same calendar day(s). Patentees state that the total period of Office delay is the sum of 366 days of delay under 37 CFR 1.702(b) ("Three Year Delay")<sup>1</sup> and 658 days of delay under 37 CFR 1.702(a) ("examination delay") to the extent that these periods of delay are not overlapping. Patentees contend that the periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap by 171 days (as calculated by patentees). Patentees indicate that this overlapping period is the 171 days from December 9, 2006 to May 29, 2007. Therefore, patentees assert that they are entitled to the sum of 658 (440 + 171 + 47) days of examination delay plus 366 days of Three Year Delay minus 171 days of overlap, reduced by 118 days of applicant delay, for a total patent term adjustment of 735 days.

Patentees' interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

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<sup>1</sup> Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b)[.]

As explained in *Explanation of 37 CFR 1.703(f)*<sup>2</sup> and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the

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<sup>2</sup> Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together, the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

It is noted, however, that delays resulting in the Office's failure to meet the time frames specified in 35 U.S.C. 154(b)(1)(A) (the "fourteen-four-four-four" provisions) are not always overlapping with a delay resulting in the Office's failure to issue a patent within the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) because not all application pendency time is counted toward this three-year period. See 35 U.S.C. 154(b)(1)(B)(i)-(iii).

In this instance, all application pendency time is not counted toward the three-year period. A request for continued examination was filed on October 30, 2007. The period subsequent to the filing of the RCE is not included in the three-year time frame specified in 35 U.S.C. 154(b)(1)(B). See 35 U.S.C. 154(b)(1)(B)(i). Thus, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period from the filing of the application on October 29, 2003, to the filing of the RCE on October 30, 2007. Thus, only the 611 days<sup>3</sup> of patent term adjustment accorded prior to the filing of the RCE pursuant

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<sup>3</sup> The Office did not mail a non-final Office action until March 14, 2006, 14 months and 440 days after the application was filed on October 29, 2003. Additionally, the Office did not respond to the reply of August 9, 2006, until the mailing of a final Office action on May 29, 2007, 4 months and 171 days later.

to 37 CFR 1.702(a)(1) and (a)(2)<sup>4</sup> are considered in determining overlap. The 47 days<sup>5</sup> for Office delay under 37 CFR 1.702(a)(2), occurring after the filing of the RCE is not considered. The 366 days attributed to Office delay pursuant to 37 CFR 1.702(b) for failure to issue the patent within three years after the filing of the application is determined to overlap with the 611 days attributed to Office delay pursuant to 1.702(a)(1) and (a)(2). 658 (611 + 47) days is the actual number of days issuance of the patent was delayed. Accordingly, at issuance, the Office properly entered no additional period of adjustment, having considered the 366 days of Office delay under the three-year pendency provision.

In view thereof, the Office affirms the revised determination of patent term adjustment at the time of the issuance of the patent is 540 days (658 (611 + 47) days of Office delay - 118 days of applicant delay).

The \$200.00 fee set forth in 37 CFR 1.18(e) will be charged to the Deposit Account as authorized. No additional fees are required.

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<sup>4</sup> 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

<sup>5</sup> The Office did not respond to the reply of April 22, 2008, until the mailing of the Notice of Allowance on October 8, 2008, 4 months and 47 days later.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

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